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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,167	03/07/2001	Roger Gillman	P/67-1	4310

7590 07/27/2005
Phillip M. Weiss, Esq.
Weiss & Weiss
300 Old Country Road
Suite 251
Mineola, NY 11501

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,167

Applicant(s)

GILLMAN ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 May 2005 has been entered.

Response to Arguments

2. Applicant's arguments filed with an amendment on 9 May 2005 have been fully considered but they are not persuasive. The following rejection is not materially different from that mailed on 8 February 2005, and accordingly could have been made final. However, the examiner finds that the 8 February 2005 was not as clear as it should have been. The following rejection has been rewritten to better address applicant's arguments and has been made non-final. In particular, a discussion of what the examiner believes applicant is trying to claim has as been added (para. 17 below).

Claim Rejections - 35 USC § 102 and 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyd.
6. Boyd teaches (independent claims 1 and 8) a method and system for providing online networking groups, the method comprising: registering three or more users by asking them to store information in *user profile database 213* (para. [0064] and [0085-0086]), which reads on entering a profile and a second profile (and a third profile) into a computer database, and creating a networking group (all three or more users/members) contained within said computer database; and a first user forming and posting an invitation to a networking meeting to two or more other users ([0049 and 0024]), the *selection preferences and criteria* including that the attendees be *intellectual property lawyers* ([0031]), the invitation being placed in *invitation database 211*, which reads on comparing said profile and said second profile (comparing both user profiles to the *selection preferences and criteria*)¹, moving said second profile into a second database (*invitation database 211*) is said second profile and said second profile contain same professions and same areas of practice (*intellectual property lawyers*), and creating a network group (the invited members) contained in said second database (*invitation database 211*). Said posting an invitation to a networking meeting to two or more other users and receiving acceptances ([0044]) reads on networking online within a networking group.
7. Interpretation of "networking online" Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe the invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

¹ Things compared to the same thing are compared to each other.

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8. In the instant case, no such clear definition of "networking online" was found in the specification. The term is used in the original specification only in the abstract and para. [0001], and in claims 1 and 8. These uses meet none of the tests given in para. 7 above for a "clear definition". Hence, the examiner is required to give the term its broadest reasonable interpretation (MPEP § 2111), which the examiner judges to be any online exchange of information among individuals, groups or institutions (Merriam-Webster Collegiate Dictionary definition of "networking").² Hence "online networking" is also taught by the reference, as indicated in the last sentence of para. 6 above.
9. It would behoove applicant, with the help of his learned attorney, to fully understand the principle and basis of the judgment given in para. 7 and 8 above. Restated, the law permits applicant to use words in any special way that applicant wishes, but only if said words are given a "clear definition" in the spec. No such clear definition was found in the spec. In such a case, the examiner is required to give the term its broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach. The examiner judged that a certain dictionary definition meets these criteria.
10. The examiner's review of the arguments and the specification (especially para. [0004] and [0005]) suggest that applicant is interpreting "networking online" to mean *meeting* online (actually *networking meetings* in para. [0004] and [0005]). In the examiner's judgment, that is not an acceptable interpretation because it is not supported by a "clear definition" in the specification. Indeed, the two phrases "networking online" and "networking meetings" do not even appear in the same paragraph of the spec. The claims could be limited to meeting online/online meetings, as discussed at para. 17 below.
11. Boyd also teaches at the citations given above claim 2 (where the invitation reads on a referral). Boyd also teaches claims 5 ([0073]) and 7 ([0065-0066]).
12. Applicant argues (p. 6, second para.) that an invitation does not read on a referral. Again, without a clear definition in the spec, the examiner has relied on the Merriam-Webster Collegiate Dictionary definition 2a of "referring", to send for aid or information. An invitation does that. As to claim 5, the reference teaches removing inactive members (para. [0073]),

² Made of record herein is a 23 July 2005 printing of said definition. This is a revision of the definition made of record with the Office action mailed on 8 February 2005.

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which reads on removing members who do not provide referrals; an inactive member clearly cannot provide referrals.

13. Claims 3, 4 and 6 are rejected under 35 U.S.C. 103(a) as obvious over Boyd.
14. Boyd does not teach (claims 3 and 4) rewards or positive incentives commensurate with the number of invitations/referrals provided by a user. However, Boyd does teach negative incentives for a user who does not make invitations or violate invitation rules ([0053, 0073-0075 and 0111]). Because the system would work only if user make as well as honor invitations, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Boyd rewards or positive incentives commensurate with the number of invitations/referrals provided by a user.
15. Applicant argues (p. 7 first full para.) that Boyd only suggests a one-time meeting, so there is no reason for providing incentives. Applicant's facts are in error: Boyd teaches "meetings" (plural) in para. [00022], third line.
16. Boyd does not teach (claim 6) communicating online via video/audio conferencing. However, Boyd does teach a system with video monitors and cameras ([0094 and 0101]). Because Boyd teaches that the purpose of the reference invention is to make the best use of a user's time ([0006]), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Boyd) meeting by video/audio conferencing.

Discussion of the Disclosed Invention

17. Boyd does not teach or suggest meeting online, which is disclosed in the spec. (para. 10 above). Hence, the instant rejection could be overcome by limiting the claims to meeting online. Unfortunately, the examiner cannot offer encouragement because this limitation is taught in the following references, and the examiner believes it would have been obvious to add these teachings to those of Boyd. The references are: Romano ("Meet me in Cyberspace", Association Management, v. 50, n. 9, p. 24(8), September 1998) and Dailey et al. (US006363352B1).

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The

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examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

19. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

**DONALD L. CHAMPAGNE
PRIMARY EXAMINER**

Donald L. Champagne
Primary Examiner
Art Unit 3622

23 July 2005